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To: Examiner David A. Lambertson	Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	(703) 872-9306	(571) 272-0771
From: David P. Halstead, Ph.D. Reg. No. 44,735			
Re: Applicant: Johnsson et al. Serial No.: 09/923,917 Filed: August 6, 2001 For: SPLIT-UBIQUITIN BASED REPORTER SYSTEMS AND METHODS OF THEIR USE	Attorney Docket No.: DFMP-P01-017 Art Unit: 1635 Examiner: Lambertson, David A.		

Comments: Official Papers – Reply to Restriction Requirement (2 pages)**PLEASE COMPLETE WHEN SUBMITTING TO FAX DEPARTMENT**

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SEP 13 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOHNSSON *et al.*

Serial No: 09/923,917

Filed: August 6, 2001

For: SPLIT-UBIQUITIN BASED
REPORTER SYSTEMS AND
METHODS OF THEIR USE

Attorney Docket No. DFMP-P01-017

Art Unit: 1636

Examiner: Lambertson, David A.

CERTIFICATE OF FACSIMILE UNDER 37 C.F.R. 81.8(a)

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, facsimile no. (703) 872-9306, on the date shown below.

September 13, 2004

Date of Signature and of Mail Deposit


Mary Jane DiPalma

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

Sir:

This amendment is being filed in reply to the outstanding Restriction Requirement Office Action, mailed August 11, 2004, in connection with the above application. Please enter the following amendments:

Applicants hereby elect Group IX, claims 66-114, *with traverse*, on the following grounds.

Applicants first note that, although several claims are included in more than one group, several claims, including claims 20 and 66-68, are not included in any of the nine Groups in the Restriction Requirement.

Applicants intend to elect the group encompassing claims 66-68 with traverse. In an attempt to clarify, Applicants' agent called the Examiner on Friday, September 10, 2004, but was

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unable to reach the Examiner. Since dependent claims 71-81 of Group IX all depend on claim 66, Applicants assume that "Group IX (claims 69-114)" was merely a typographical mistake, and the Examiner intended to include claims 66-68 in Group IX.

Applicants traverse this restriction requirement on the basis that all Groups share certain common technical features as disclosed in the specification. Although different groups of independent claims may have additional features, a search of the common technical feature (e.g., the ubiquitin-based fusion proteins) may potentially relate to all claims, and would not increase the search burden of the Examiner. For example, claim 66 includes most (if not all) of the limitations of claim 1, thus examining claim 66 necessarily requires examining the subject matter of claim 1, and there would be no additional search burden for the Examiner. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (MPEP 803). Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition therefor and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

Date: September 13, 2004

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